

REMARKS

Applicants thank the Examiner for the courtesy extended to Applicants' attorney during the interview held November 15, 2005, in the above-identified application. During the interview, Applicants' attorney asked the Examiner whether an amendment incorporating the subject matter of any of Claims 2-7, found allowable by the Examiner in the first Office Action, into original Claim 1, would be entered "after Final." The Examiner indicated that such an amendment would be entered. Nevertheless, the discussion is moot, since the claims have not been so amended. As discussed in further detail below, the claims are patentable as now pending, since the below-discussed rejection is not supported by law.

The rejection of Claims 1-7 under 35 U.S.C. § 112, first paragraph, as failing to comply with the *description* requirement thereof, is respectfully traversed.

Present Claim 1 requires, *inter alia*, a cyclic olefin based addition **copolymer containing at least one repeating unit selected from repeating units represented by general formulae (1) to (3) and at least one repeating unit selected from repeating units represented by general formulae (4) to (7).** (Emphasis added.) Original Claim 1 required . . . at least one repeating unit selected from repeating units represented by general formulae (1) to (7). The Examiner finds that the above-emphasized limitation lacks descriptive support in the original disclosure.

In reply, Applicants maintained (and still maintain) that the limitation is supported by the various examples, which show copolymers of bicyclo compounds, i.e., of formulae (1)-(3), and, for example, tricyclo compounds, i.e., of formulae (4)-(7).

It is well-settled that the test for compliance with the *description* requirement is whether, as an issue of fact, a person skilled in the art would reasonably conclude from the disclosure whose filing date is being relied on that the inventor had possession as of that date of the later claimed invention, and how the disclosure accomplishes this fact is unimportant.

See, e.g., Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991), and cases cited therein. Such cases are to be decided on a “case-by-case basis.” *See, e.g., Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ 2d 1467, 1470 (Fed. Cir. 1995). Satisfaction of the *description* requirement insures that subject matter presented in the form of a claim *subsequent* to the filing date of the application was sufficiently disclosed at the time of filing so that the *prima facie* date of invention can fairly be held to be the filing date of the application. *In re Smith and Hubin*, 481 F.2d 901, 914, 178 USPQ 620, 623 (CCPA 1973), *quoted in Vas-Cath*, 935 F.2d at 1562, 19 USPQ2d at 1115-16. It is thus irrelevant that the above-emphasized term does not appear *in haec verba* in the specification. See also MPEP 2163.

In *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), the CCPA explicitly recognized that inventors occasionally discover that their contributions to the art are not as broad as they first thought. The court stated:

Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable. As we said in a different context (citation omitted):

To rule otherwise would let form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed. Cf. (citation omitted). Since the patent law provides for the amendment during prosecution of *claims*, as well as the specification supporting the claims, 35 USC 132, it is clear that the reference to “particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention” in the second paragraph of 35 USC 112 does not prohibit the applicant from changing what he “regards as his invention” (i.e., the subject matter on which he seeks patent protection) during the pendency of his application. Cf. (citation omitted).

541 F.2d at 263, 191 USPQ at 97.

The CCPA soon had occasion to apply the above in *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977), holding that a claim to a genus with a recital of a negative

proviso that did not appear in the specification complied with the *description* requirement. The negative proviso had the effect of excluding from the scope of the claim two species originally disclosed in the specification as within the invention, and was inserted to avoid having the claims read on a lost interference count. The claim recited a formula O-E-O-E', wherein E and E' were both positively defined, and ended "with the provisos that E and E' may not both include a divalent sulfone group and may not both include a divalent carbonyl group linking two aromatic nuclei." The proviso literally excluded more than the two species. *Id.* at 1013 n.12; 194 USPQ at 191 n.12. The court stated:

The notion that one who fully discloses and teaches those skilled in the art how to make and use a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result in hypertechnical application of legalistic prose relating to that provision of the statute.

Id. at 1019, 194 USPQ at 196.

A few months later, the CCPA had another opportunity to review "the sort of 'hypertechnical application' of the written description requirement of §112 which was recently criticized in [*Johnson*]" in *In re Driscoll*, 562 F.2d 1245, 1249-50, 195 USPQ 434, 438 (CCPA 1977) (**copy enclosed**). In holding that a disclosure of a group of chemical compounds containing a plurality of groups defined by Markush terminology, one of which groups contained 14 members, *described* the same group of compounds otherwise identical except that the 14-member group was now limited to only one of the members, the court stated:

Were the board's decision permitted to stand, future applicants, particularly in cases of this nature, would in all likelihood find themselves in the predicament reflected in the following observation by Judge Learned Hand:

If, when [applicants] yield any part of what they originally believed to be their due, they substitute a new "invention," only two courses will be open to them: they must at the outset either prophetically divine what the art contains, or they must lay down a barrage of claims, starting with the widest and

proceeding by the successive incorporation of more and more detail, until all combinations have been exhausted which can by any possibility succeed. The first is an impossible task; the second is a custom already more honored in the breach than in the observance, and its extension would only increase that surfeit of verbiage which has for long been the curse of patent practice, and has done much to discredit it. *It is impossible to imagine any public purpose which it would serve.*

Id. at 1250 (quoting *Engineering Development Laboratories v. Radio Corp. of America*, 153 F.2d 523, 526-27, 68 USPQ 238, 241-42 (2d Cir. 1946)).

Indeed, the present situation closely resembles *Driscoll*, since the original term "**at least one** repeating unit selected from repeating units represented by general formulae (1) to (7)" (emphasis added) is, in essence a Markush group of general formulae (1) to (7) **and all possible combinations thereof**. *Driscoll* supports narrowing of a Markush group.

In sum, one skilled in the art would appreciate that Applicants were in possession as of the filing date of the presently-claimed method, wherein, *inter alia*, a step of coating the surface of a first dielectric film formed on a semiconductor substrate is carried out with a cyclic olefin based addition copolymer containing at least one repeating unit selected from repeating units represented by general formulae (1) to (3) and at least one repeating unit selected from repeating units represented by general formulae (4) to (7).

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

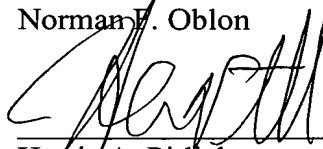
Application No. 10/693,929

Reply to Final Office Action dated September 22, 2005

All of the presently-pending claims in this application are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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FULL TEXT OF CASES (USPQ FIRST SERIES)

In re Driscoll, 195 USPQ 434 (CCPA 1977)

In re Driscoll**(CCPA)****195 USPQ 434****Decided Oct. 6, 1977****No. 77-560****U.S. Court of Customs and Patent Appeals****Headnotes****PATENTS****1. Application for patent -- Continuing (§ 15.3)****Construction and specification of claims -- In general (§ 22.01)****Specification -- Sufficiency of disclosure (§ 62.7)**

Earlier filed application's disclosure must be viewed as it would be by person skilled in art, to determine whether it reasonably conveys information that as of its filing date applicant possessed class of compounds defined in present claim, to determine if applicant is entitled to earlier filing date.

2. Claims -- Broad or narrow -- Markush type (§ 20.205)

It is generally understood that in so describing class of compounds applicant is, in effect, asserting that members of Markush group do not fall within any recognized generic class, but are alternatively usable for purposes of invention, and therefore, regardless of which of alternatives is substituted on basic structure, compound as whole will exhibit disclosed utility.

3. Specification -- Sufficiency of disclosure (§ 62.7)

Each case involving questions of compliance with 35 U.S.C. 112 description requirement must be decided on its own facts, so that precedential value of cases in this area is extremely limited.

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4. Disclaimer -- In general (§ 32.1)**Pleading and practice in Patent Office -- Rejections (§ 54.7)**

Applicant's failure to file terminal disclaimer in parent application is not proper basis for rejecting continuation in part application on grounds of obviousness-type double patenting.

Particular patents -- 5-Substituted Thiadiazole Ureas

Driscoll, 5-Substituted Thiadiazole Ureas and Their Use as Herbicides, rejection of claim 13 reversed.

Case History and Disposition:

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Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Patrick R. Driscoll, Serial No. 316,794, filed December 20, 1972. From decision rejecting claim 13, applicant appeals. Reversed.

Attorneys:

Michael G. Gilman, Palisades, N.Y., for applicant.

Joseph F. Nakamura (Jack E. Armore, of counsel) for Commissioner of Patents and Trademarks.

Judge:

Before Markey, Chief Judge, Rich, Baldwin, and Miller, Associate Judges, and Almond, Senior Judge.

Opinion Text**Opinion By:**

Almond, Senior Judge.

This is an appeal from the decision of the Patent and Trademark Office (PTO) Board

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of Appeals (board) affirming the rejection of claim 13 of appellant's application, serial No. 316,794, filed December 20, 1972, for "5-Substituted Thiadiazole Ureas and Their

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Use as Herbicides." ¹ We reverse.

The Invention

The invention relates to 5-alkylsulfonyl-1,3,4-thiadiazole ureas which are useful in controlling undesired plant growth.

The appealed claim (paragraphing supplied) reads:

13. A Compound of the Formula

Graphic material consisting of a chemical formula or diagram set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.

wherein R is alkylsulfonyl (C 1-C 6);

R ₁ is selected from the group consisting of H, alkyl (C 1-C 4), and cycloalkyl (C 3-C 6);

R ₂ is from the group consisting of H, alkyl (C 1-C 4), haloalkyl (C 1-C 4), alkoxy (C 1-C 4), alkenyl (C 2-C 4), alkynyl (C 2-C 4), aryl, and haloaryl, and wherein R ₁ and R ₂ are alkylene which, together with N, form a ring of at least 3, but not more than 6 members;

R ₃ is H or alkyl (C 1-6); and X is selected from the group consisting of oxygen and sulfur.

Background

Pursuant to 35 USC 120, ² appellant has claimed the benefit of an earlier filing date based on a series of previously filed applications, the present application being designated a continuation-in-part of application serial No. 113,679, filed February 8, 1971 (S.N. 113,679), which is a continuation-in-part of application serial No. 818,078, filed April 21, 1969, which, in turn, is a continuation-in-part of application serial No. 782,756, filed December 10, 1968 (S.N. 782,756). ³

S.N. 782,756 contains the following disclosure relied on by appellant to support his claim under §120:

In accordance with the invention, there is provided a compound of the formula [paragraphing supplied]:

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wherein R is selected from the group consisting of H, alkyl (C 1-C 6), haloalkyl (C 1-C 6), cycloalkyl (C 3-C 6), halocycloalkyl (C 3-C 6), alkoxy, alkoxyalkyl, alkoxyalkylthio, aryl, substituted aryl, alkenyl (C 2-C 6), alkylthio (C 1-C 6), alkylsulfoxide (C 1-C 6), and alkylsulfonyl (C 1-C 6);

R ₁ is selected from the group consisting of H, alkyl (C 1-C 4), and cycloalkyl (C 3-C 6);

R ₂ is from the group consisting of H, alkyl (C 1-C 4), haloalkyl (C 1-C 4), alkoxy (C 1-C 4), alkenyl (C 2-C 4), alkynyl (C 2-C 4), aryl and haloaryl, and

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wherein R₁ and R₂ are alkyl which, together with N, form a ring of at least 3, but not more than 6 members;

R₃ is H or alkyl (C₁₆); and X is selected from the group consisting of oxygen and sulfur.

Original claim 1 of S.N. 782,756 is a verbatim recitation of the above structural formula.

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Proceedings in the PTO

Claim 13 was rejected under 35 USC 102 as anticipated by Belgian patent No. 743,615, the effective reference date of which is June 23, 1970. The examiner took the position that appellant was not entitled to the benefit of a filing date prior to the reference date because nowhere in appellant's earlier filed applications was there a written description of the subject matter of claim 13 in "full, clear, and exact terms," as required by 35 USC 112. According to the examiner:

One skilled in the art reading [the portion of the disclosure of S.N. 782,756 relied on by appellant] would simply not conceive of, without more, the new genus reflected in instant claim 13. [Emphasis in original.]

Accordingly, the examiner concluded that inasmuch as the reference discloses several compounds embraced by the appealed claim and has an effective date more than one year prior to the filing date of the present application, it constitutes a statutory bar under §102.

In sustaining the examiner's rejection, the board stated:

In view of the relatively large number of possible values for R, and in the absence of anything in the disclosure to direct one specifically to the subgenus where R is alkylsulfonyl, we cannot agree with appellant's position. * * * To hold otherwise would be to find within appellant's generic description also a description of each subgenus wherein R₁ was selected from a single member of the group disclosed, while retaining the generic description of the remaining variable symbols, and each subgenus obtained by carrying out a similar operation with R₂ and R₃ and X. We think it clear that the single generic description relied on, in the absence of any additional subgeneric disclosure, is incapable of constituting a written description of so many different genera or subgenera of chemical compounds in the manner required by the statute.

The examiner also rejected claim 13 on the ground of double patenting over the claims of S.N. 113,679. 35 USC 101⁵ was cited as the statutory basis of rejection.⁶ However, the board sustained the rejection on a different basis, stating that:

The examiner has incorrectly cited 35 U.S.C. 101 as the basis of his rejection. Although claims 1, 9, 19 and 20 of the co-pending, earlier filed application read on subject matter comprehended by the claim here on appeal, none of the former claims are equivalent in scope to the latter claim. Thus the claims of the parent application are not drawn to the same invention as the claim before us, and 35 U.S.C. 101 is not applicable. However, the judicially created doctrine of double patenting of the obviousness type is clearly appropriate in this situation, as

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appellant is evidently aware since a terminal disclaimer has been filed in this case. [Citations omitted.] Inasmuch as no terminal disclaimer has been filed in the parent application, however, the potential extension of monopoly upon which this rejection is grounded has not been obviated, and the examiner's rejection must be affirmed.

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Claim 13 was further rejected "as being unpatentable over a count of Interference No. 98,209," ⁷ as well as on the grounds that the present specification provides inadequate enabling support for the full scope of the claim (35 USC 112, first paragraph) and that the claim fails "to define the invention clearly" (35 USC 112, second paragraph). The board reversed the latter rejections.

Opinion

The 35 USC 102 rejection.

Appellant does not dispute that the appealed claim is anticipated by the Belgian patent if the present application is not entitled to the earlier filing date of S.N. 782,756. Consequently, the sole issue with respect to this aspect of the appeal is whether the disclosure of S.N. 782,756 describes the subject matter of claim 13.

[1] In resolving this issue, we must view the disclosure of the earlier filed application as would a person skilled in the art and determine whether it reasonably conveys the information that as of the filing date thereof appellant had possession of the class of 5-alkylsulfonyl-1,3,4-thiadiazole ureas defined in claim 13. We are satisfied that it does.

A comparison of the appealed claim with the class of compounds disclosed in S.N. 782,756 reveals that the only difference therebetween lies in the definition of the substituent designated by R. In the appealed claim, R is simply alkylsulfonyl (C₁-C₆), whereas in the earlier application, R corresponds to a Markush group of fourteen variable substituents (the R group), one of which is alkylsulfonyl (C₁-C₆).

[2] The practice of describing a class of chemical compounds in terms of a structural formula wherein the substituents thereof are defined as "a member selected from the group consisting of A, B, C, D, * * *" was sanctioned by implication in *Ex parte Markush*, 1925 C.D. 126, 340 O.G. 839, the first decision to consider the propriety of claims so expressed -- hence, the name "Markush group." It is generally understood that in thus describing a class of compounds an applicant is, in effect, asserting that the members of the Markush group do not fall within any recognized generic class, but are alternatively usable for the purposes of the invention, and therefore, regardless of which of the alternatives is substituted on the basic structure, the compound as a whole will exhibit the disclosed utility.

An example will serve to illustrate this point. Assume that instead of the foregoing structural formula, S.N. 782,756 expressly disclosed a class of herbicides represented by the formula

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"wherein R is selected from the group consisting of H, alkyl (C₁-C₆), haloalkyl (C₁-C₆), cycloalkyl (C₃-C₆) * * * alkylsulfonyl (C₁-C₆)" (i.e., R as defined in S.N.782,756). Given the rationale underlying the use of Markush groups, one skilled in the art would view the above formula as a description of fourteen distinct classes of 5-substituted thiadiazole ureas, each possessing herbicidal activity, just as if the application had listed a first structural formula wherein R was hydrogen, a second wherein R was alkyl (C₁-C₆), a third wherein R was haloalkyl (C₁-C₆), and so on.

Although the preceding example was adduced for illustrative purposes, we believe that, in reality, the exemplified structural formula constitutes the essence of appellant's invention and that one skilled in the art would recognize it as such from the earlier filed application.

S.N.782,756 points up appellant's contribution to the art with the statement that:

Particularly effective [herbicides] are [thiadiazole ureas] which contain an organic substituent in the 5-position of the thiadiazole portion.

Thus, the focus is unquestionably on the substituents at the 5-position of the thiadiazole moiety, and not on the substituents of the urea moiety. Accordingly, one skilled in the art would regard the structural formula of S.N.782,756 as signifying that no matter which member of the R group is present on the thiadiazole moiety, the urea moiety may be substituted or unsubstituted.

We thus agree with appellant that a skilled artisan would recognize from the disclosure of S.N.782,756 fourteen distinct classes of compounds, each class having a

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single member of the R group at the 5-position of the thiadiazole moiety and variable substituent groups on the urea moiety. This being the case, it follows that S.N.782,756 describes the subject matter of claim 13 inasmuch as one of the fourteen classes of compounds is the 5-alkylsulfonyl-1,3,4-thiadiazole ureas defined therein.

This record presents yet another instance of the sort of "hypertechnical application" of the written description requirement of §112 which was recently criticized in *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977).⁸ Were the board's decision permitted to stand, future applicants, particularly in cases of this nature, would in all likelihood find themselves in the predicament reflected in the following observation, by Judge Learned Hand:

If, when [applicants] yield any part of what they originally believed to be their due, they substitute a new "invention," only two courses will be open to them: they must at the outset either prophetically divine what the art contains, or they must lay down a barrage of claims, starting with the widest and proceeding by the successive incorporation of more and more detail, until all combinations have been exhausted which can by any possibility succeed. The first is an impossible task; the second is a custom already more honored in the breach than in the observance, and its extension would only increase that surfeit of verbiage which has for long been the curse of patent practice, and has done much to discredit it. *It is impossible to imagine any public purpose which it could serve.* [Emphasis added.]

Engineering Development Laboratories v. Radio Corp. of America, 153 F.2d 523, 526-27, 68 USPQ 238, 241-242 (CA2 1946).

Aside from reiterating the reasons advanced by the board for affirming the examiner's rejection, the solicitor asserts that In re Ruschig, 54 CCPA 1551, 379 F.2d 990, 154 USPQ 118 (1967), "may be considered controlling in the present appeal." We disagree.

Ruschig involved a claim drawn to a single compound, N-(p-chlorobenzenesulfonyl)-N'-?? propylurea (the structure of which is reproduced in the opinion). The PTO rejected that claim, which was added by amendment, contending that it was not described in the application as originally filed. As presently pointed out by the solicitor, one of the arguments there advanced to overcome the rejection was that the subject matter of the appealed claim was described in an original claim setting forth the structural formula of a benzenesulfonyl-urea having two variable substituents defined as Markush groups. Any seeming similarity between Ruschig and the present case is illusory, however, because the structural formula there relied on could have described, at best, only a subgenus including the specific compound claimed, and not the compound itself. In this respect, Ruschig is readily distinguishable from the present case where the exact subgenus claimed is clearly discernible in the generalized formula of the thiadiazole urea set forth in the earlier filed application.

[3]Moreover, it should be readily apparent from recent decisions of this court involving the question of compliance with the description requirement of §112 that each case must be decided on its own facts. Thus, the precedential value of cases in this area is extremely limited.

Upon the facts of this case, we conclude that the subject matter of claim 13 is described in S.N.782,756. The other requirements of 35 USC 120 presumably having been met, the present application is entitled to the benefit of a filing date prior to the effective date of the Belgian patent. Accordingly, we reverse the rejection of claim 13 under 35 USC 102.

The double patenting rejection.

Although appellant questions the propriety of rejecting claims in one application on

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the grounds of obviousness type double patenting over claims of a copending application of the same inventor, we leave the resolution of this issue for another day. We choose instead to assume, arguendo, that claim 13 has been properly rejected and to consider whether appellant's terminal disclaimer under 35 USC 253⁹ overcomes the rejection.

As was stated in In re Thorington, 57 CCPA 759, 765, 418 F.2d 528, 534, 163 USPQ 644, 648 (1969):

[D]ouble patenting rejections usually take one or both of two forms, namely, the "same invention" type "double patenting" identifiable with the statutory provision 35 U.S.C. 101, saying that an inventor may obtain a patent, interpreted as meaning only one patent; and the "obviousness" type "double patenting," a judicially-created doctrine grounded in public policy rather than statute and primarily intended to prevent prolongation of monopoly by prohibiting claims in a second patent not patentably distinguishing from claims of a first patent. This

court has held that a terminal disclaimer is ineffective where it is attempted to twice claim the same invention; however, an "obviousness" type "double patenting" rejection may be obviated by a terminal disclaimer. [Emphasis in original.]

[4]As previously indicated, notwithstanding the examiner's citation of 35 USC 101, the board relied on the judicially-created doctrine of obviousness type double patenting in upholding the rejection of claim 13 over certain claims of S.N.113,679. ¹⁰ As to the effect of appellant's filing of a terminal disclaimer in the present application, however, the board maintained that since no terminal disclaimer had been filed in S.N.113,679, "the potential extension of monopoly upon which this rejection is grounded has not been obviated * * *." We consider this line of reasoning unsound, inasmuch as the claim in this application, which is all that we are presently concerned with, is subject to the terminal disclaimer. If the present application should go to issue during the pendency of S.N.113,679, and the latter contains potentially conflicting claims, the proper procedure would be, at that time, to reject those claims for double patenting over the claim of the present application. Appellant's failure to file a terminal disclaimer in S.N.113,679 at this time cannot justify the denial of the claim here on appeal. Accordingly, we reverse the double patenting rejection.

Footnotes

Footnote 1.

Mobil Oil Corp. is the real party in interest.

Footnote 2.

Section 120 provides:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

The first paragraph of section 112 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Footnote 3. The "genealogy" of the present application can be traced through additional earlier filed applications, the disclosures of which are irrelevant to the present controversy.

Footnote 4. The basic structure of the compounds here involved may be viewed as a combination of two distinct moieties:

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The portion on the left is a thiadiazole moiety which is a five-membered heterocycle, the members of which have been numbered in accordance with convention. When X is oxygen, the portion on the right is a urea moiety, urea having the formula $\text{NH}_2\text{-CO-NH}_2$. When X is sulfur, the portion on the right is a thiourea moiety.

Footnote 5.

Section 101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Footnote 6. In the examiner's Answer, appellant was required for the first time to eliminate the conflicting claims from all but one of the copending applications pursuant to 37 CFR 1.78(b), which provides:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Appellant responded to this requirement in his reply brief by electing to prosecute the claims in the present application and indicating that the conflicting claims in S.N. 113,679 would be canceled "at an appropriate time."

Footnote 7. S.N. 113,679 was involved in Interference No. 98,209. Prior to the board's decision, but subsequent to the mailing of the examiner's Answer, the interference was terminated in appellant's favor. Accordingly, the board considered the rejection moot.

Footnote 8. In that case a class of thermoplastic polyarylene polyethers was disclosed and claimed in a 1963 application which became involved in an interference, the award of priority therein being adverse to Johnson and Farnham. The sole interference count recited a single species within the class of polyethers originally claimed. In 1972 a continuation-in-part application was filed containing claims which differed from the broad claims of the earlier application by reciting a proviso that excluded, inter alia, the subject matter of the lost count. Those claims were rejected under 35 USC 102 on the basis of a Netherlands patent, which was a counterpart of the 1963 application. There, as here, the benefit of an earlier filing date was denied because the newly claimed subject matter was allegedly not described in the earlier application. In reversing the rejection, the court there observed that the applicants were merely excising the invention of another, to which they were not entitled, rather than creating an artificial subgenus or claiming new matter.

Footnote 9.

Section 253 provides:

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his

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interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted. [Emphasis added.]

Footnote 10. S.N.113,679, claims 1, 9, 19, and 20 of which were cited by the board in upholding the double patenting rejection, does not appear in the record. However, since appellant has failed to argue otherwise, we assume that the appealed claim is a mere obvious variant of the cited claims.

- End of Case -